

## **REMARKS**

### **Non-Art Matters**

#### **I. Election/Restriction**

The Examiner has asserted that claims 54-55 and 61-72 are directed to an invention that is independent or distinct from the invention originally claimed. According to the Examiner, because Applicant has already received an action on the merits for the originally presented invention, the invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, the Examiner has withdrawn claims 54-55 and 61-72 from consideration as being directed to a non-elected invention. To conform to the Examiner's actions, Applicant has withdrawn claims 54-55 and 61-72, as denoted in the Listing of Claims.

#### **II. Priority**

The Examiner has denied Applicant's claim of priority to U.S. Patent Application Serial No. 08/537,765, now US Patent No. 6,160,169, relative to claims 47-53 and 56-60. Accordingly, Applicant has withdrawn without prejudice claims 47-53 and 56-60, as denoted in the Listing of Claims.

Applicant thanks the Examiner for granting the claim of priority with respect to claims 22-24, 26-29, 32-34 and 41-42.

#### **III. Terminal Disclaimer to Obviate a Double Patenting Rejection over a Prior Patent**

The Examiner has rejected claims 22-24, 26-29, 32-34, 41-42 and 73-74 under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 6,150,169. Accordingly, the owner, The University of Edinburgh,

of a 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 6,150,169, which prior patent is also owned by The University of Edinburgh. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patents are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patents, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer. A Terminal disclaimer fee under 37 CFR 1.20(d) is included herein.

### **Art Matters**

#### **I. Claim Rejections - 35 USC 112(1)**

The Examiner has rejected claims 47-53 and 56-60 under 35 USC 112(1) as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner has also rejected claims 47-53 and 56-60

under 35 USC 112(1) as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Accordingly, Applicant has withdrawn without prejudice claims 47-53 and 56-60, as denoted by the Listing of Claims.

Applicant acknowledges with gratitude the Examiner's withdrawal of the new matter and enablement rejections of claims 22-24, 26-29, 32-34 and 41-41.

## **II. Claim Rejections - 35 USC 102**

The Examiner has rejected claims 47-50, 52-53 and 56-57 under 35 USC 102(e) as being anticipated by Tessier-Lavigne et al. (U.S. Patent No. 6,248,934). Accordingly, Applicant has withdrawn without prejudice claims 47-50, 52-53 and 56-57.

### **Miscellaneous**

Applicant has amended claims 22 and 32 to better define Applicant's invention. No new matter has been entered by these amendments. Support for these amendments may be found in specification at page 7, paragraph 3, sentence 2 (which reads as "In an embodiment of the invention linker region A includes or consists of a splice acceptor") and at pages 9-10, paragraph 4 beginning on page 9, sentence 4 (which reads in part as "...in a further aspect of the invention, incorporate a splice acceptor sequence 5' to the IRES element to enable functional integration into an intron.")

It is submitted that the pending claims are in a condition for allowance. Early notice to that effect is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees that may be

required, or credit any overpayment, to Deposit Account No. 50-0902 (78870/32932).

The undersigned is an attorney of record.

Respectfully submitted,

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1/30/04  
Date

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I hereby certify that this correspondence (along with any paper referenced as being attached or enclosed) is being deposited on the below date with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

Date: 1-30-04

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